

In the office action mailed February 14, 2002:

- 1) claims 1-5 were rejected under 35 U.S.C. 103(a) as being unpatentable over EP 960 873 (hereinafter "Mauro") in view of U.S. Pat. No. 6,412,939 (hereinafter "Schultz");
- 2) claim 6 was rejected under 35 U.S.C. 103(a) as being unpatentable over Mauro in view of Schultz, further in view of U.S. Pat. No. 4,256,493 (hereinafter "Yokoyama");
- 3) claim 7 was rejected under 35 U.S.C. 103(a) as being unpatentable over Mauro in view of Schultz and Yokoyama, further in view of U.S. Pat. No. 4,136,076 (hereinafter "Daniels");
- 4) claim 8 was rejected under 35 U.S.C. 103(a) as being unpatentable over Mauro in view of Schultz, further in view of U.S. Pat. No. 6,283,589 (hereinafter "Gelbart");
- 5) claims 9-13 were rejected under 35 U.S.C. 103(a) as being unpatentable over Mauro in view of Schultz and U.S. Pat. No. 6,106,113 (hereinafter "Yamazaki");
- 6) claim 14 was rejected under 35 U.S.C. 103(a) as being unpatentable over Mauro in view of Schultz and Yamazaki, further in view of Yokoyama; and
- 7) claim 15 was rejected under 35 U.S.C. 103(a) as being unpatentable over Mauro in view of Schultz and Yamazaki, further in view of Daniels.

Claims 16-20 will be cancelled without prejudice upon allowance of the pending claims.

Rejections under 35 U.S.C. 103(a)

The Examiner has rejected all of the claims under 35 U.S.C. 103(a). In every rejection made by the Examiner, Mauro is cited as the primary reference and Schultz is cited as a secondary reference.

As stated in response to the last office action, Mauro teaches of a liquid mixture that includes metal salts having chromophore action, resins, solvents, and wetting agents. However, Mauro fails to teach the use of an ink-jet printer for applying any of the compositions. Even further, nowhere does Mauro teach, or even suggest, that any of its compositions can be jetted, such as from an ink-jet pen. In addition to these points, all of the arguments described in the last office action response with respect to Mauro are incorporated herein by reference.

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It appears that the Examiner has removed Kimura as a reference, as it does not teach or suggest the jetting of a digital image on a ceramic. After removing Kimura, the Examiner conducted a new search uncovering Schultz, a reference that does teach ink-jet printing on a ceramic. However, Schultz does not teach firing, nor does it suggest that its compositions can be fired successfully.

In any event, the Applicants' conception and reduction to practice of their method of printing on ceramics predates Schultz. See Exhibits 1-3 attached hereto, which includes two separate 37 C.F.R. 1.131 affidavits from two of the inventors (Exhibits 1-2), and evidence supporting the assertions set forth in the declarations

(Exhibit 3). Donald E. Wenzel has retired from Hewlett-Packard, and thus, is unavailable. The two affidavits and evidence attached hereto are believed to satisfy the requirements of 37 C.F.R. 1.131.

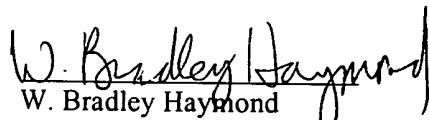
Though the Applicants disagree that Schultz renders the claims obvious, without Schultz, the asserted obviousness rejection cannot be maintained, as it appears to be integral to each of the Examiner's rejections. Reconsideration is respectfully requested.

In view of the foregoing, Applicants believe that claims 1-15 present allowable subject matter and allowance of all pending claims is respectfully requested. If any impediment to the allowance of these claims remains after consideration of the above remarks, and such impediment could be alleviated during a telephone interview, the Examiner is invited to telephone the undersigned attorney at (541) 715-0159, so that such issues may be resolved as expeditiously as possible.

Please charge any additional fees or credit any overpayment to Deposit Account No. 08-2025.

Dated this 3rd day of Oct, 2002.

Respectfully submitted,


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September 3, 2002